

REMARKS

The preceding amendments and following remarks are submitted as a full and complete response to the Office Action issued on January 29, 2008. Claims 1, 17, 18 and 31 have been amended. Claims 16 and 27 have been canceled without prejudice or disclaimer. Support for the amendments may be found in claims 16 and 27 as originally filed. No new matter has been added. Currently, claims 1-15, 17-26, 28-33 and 39-46 are pending in this application.

An objection was made to the drawings under 37 C.F.R. § 1.83(a). In particular, the Office Action asserted that three adjacent dielectric layers having gaps must be shown in the drawings or the features canceled from the claims. Applicant disagrees.

None of the claims recite "three adjacent dielectric layers having gaps." Claims 1, 11, 18, 23, 31 and 41-44 recite a "gap" in "at least" one of the layers of the interference element. A gap is shown in Figure 8 at reference number 9. Figure 8 "shows an advantageous embodiment of the invention wherein interference element 1 has gap 9, which is to be seen only in cross section in Figure 8." Paragraph 0055 of substitute specification. The gap is in all three layers of the respective interference element. Thus, Applicants submit that the objection is improper and request that it be withdrawn.

Claims 9 and 21 were rejected under 35 U.S.C. §112 first paragraph on the ground that the specification allegedly does not reasonably provide enablement for gaps in four stacked dielectric layers. Applicant respectfully traverse the rejection because claims 9 and 21 have sufficient support in the specification as required by 35 U.S.C.

§112. Namely, the gaps as claimed in claim 9 and 21 are shown as gap 9 in Figure 8, and Figure 7 illustrates the four stacked dielectric layers. Paragraphs 0054-0057 of the substitute specification disclose sufficient detail regarding how to create gaps in the four stacked dielectric layers. Thus, one skilled in the art will readily understand how to make or use the invention defined by claims 9 and 21, in view of the specification, without undue experimentation. Accordingly, Applicant submits that claims 9 and 21 comply with the requirements of 35 U.S.C. §112 and requests that the rejection of claims 9 and 21 be withdrawn.

Claims 1-8, 10-20, 22-46 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,761,959 issued to Bonkowski et al. in view of U.S. Patent No. 6,089,614 issued to Howland et al. and U.S. Patent No. 6,491,324 issued to Schmitz et al. The Applicant traverses the rejection and submits that claims 1-8, 10-15, 17-20, 22-26 and 28-46 recite subject matter that is neither disclosed nor suggested by the combination of cited prior art. Further, the rejection is improper for the additional ground that the references cannot be combined as suggested in the Office Action.

Claim 1, upon which claims 2-8, 10-15, 17, and 39-46 depend, recites a security document, or semifinished product for producing the security document, that includes a substrate with first and second opposing substrate surfaces and a multilayer security element that is so connected with the substrate that it is visually recognizable at least from one of the two substrate surfaces. The security element includes a multilayer interference element that produces a color shift effect, and also a layer with diffraction structures that at least partly overlaps the interference element. The security element is semi-transparent. The interference element has gaps in at least one layer, and the

diffraction structures directly adjoin the interference element. An effect caused by at least one of the diffraction structures and a color shift effect produced by the interference element is visually recognizable from both sides of the security element depending on the way of viewing the security element.

The Office cited Bonkowski col. 7, ll.1-6 supposedly to show a visually recognizable effect. However, the cited section of Bonkowski states that the holographic image is visible on only one side, not both sides. Bonkowski, at col. 6, ll. 65-67, describes how the optical coating is only formed on one side. Further, the substrate of Figure 1B would prevent the hologram from being visible from both sides. Further still, there is no disclosure of a hologram that is visible from two sides. Howland and Schmitz, alone or in combination, fail to cure this deficiency. Howland discloses a security document with second indicia that may be viewed from one side but not the other. Howland, col. 2 ll. 42-55. Schmitz discloses a safety document which is semitransparent on only one side. Schmitz, col. 3, ll. 9-10. Accordingly, the Applicant submits that the cited prior art fails to disclose or suggest each and every element of claims 1-15, 17 and 39-46 requests that the rejection to claims 1-15, 17 and 39-46 be withdrawn.

Claim 18, from which claims 19-26 and 28-30 depend, recites a security element to be embedded in or applied to a security document, in particular for a paper of value such as a bank note. The security element includes a multilayer interference element producing a color shift effect and a layer with diffraction structures that at least partly overlaps the interference element, characterized in that the security element is semitransparent. The interference element has gaps in at least one layer, and the

diffraction structures directly adjoin the interference element. An effect caused by at least one of the diffraction structures and a color shift effect produced by the overlying interference element are visually recognizable from both sides of the security element depending on the way of viewing the security element.

Applicant submits that claims 18-26 and 28-30 are allowable for at least the reasons above and therefore, request that the rejection thereto be withdrawn.

Claim 31, from which claims 32 and 33 depend, recites a transfer material for applying a security element to a document of value. The transfer material includes the following layer structure: a multilayer interference element with a color shift effect, and a layer with diffraction structures that at least partly overlaps the interference element. The security element is semitransparent, the interference element has gaps in at least one layer, and the diffraction structures directly adjoin the interference element. An effect caused by at least one of the diffraction structures and a color shift effect produced by the overlying interference element are visually recognizable from both sides of the security element depending on the way of viewing the security element.

Applicant submits that claims 31-33 are allowable for at least the reasons above and therefore, request that the rejection thereto be withdrawn.

In addition to the foregoing, the Applicant submits that it is improper to combine Bonkowski, Howland and Schmitz as suggested in the Office Action. Applicant submits that the skilled person would not consider Howland because the security element of Howland does not contain any of the features of the security element of the present invention, such as a multilayer interference element producing a color shift effect which element has gaps in at least one layer or a layer with diffraction structures that at least

partly overlaps and directly adjoins the interference element. Further, the skilled person, based on Bonkowski and in search of a way to achieve the above mentioned features of the present invention would not consult Schmitz either, since this document predominantly addresses a different problem, namely the problem of covering a magnetic layer of the security element (cf. Schmitz, abstract; claim 1; col. 4, ll. 61-67, with reference to Fig. 3). That is, there is no motivation for the skilled person to consider Schmitz.

Notwithstanding the above, even if the skilled artisan would consider the teaching of Schmitz appropriate for solving the underlying problem, he or she would not be pointed to the solution according to the present invention since, due to the different layer structures of the respective security elements, there is no way of combining the security element of Schmitz with the security element of Bonkowski which would be apparent to the skilled person, and such a combination would require undue experimentation or be impossible. For this separate, independent reason, the rejection to claims 1-8, 10-15, 17-20, 22-26 and 28-46 is improper.

Thus, the Applicant submits that the rejection to claims 1-8, 10-15, 17-20, 22-26 and 28-46 is improper. Accordingly, the Applicant requests that the rejection to claims 1-8, 10-15, 17-20, 22-26 and 28-46 be withdrawn and these claims be allowed.

In light of the foregoing, the Applicant submits that all outstanding rejections have been overcome, and the instant application is in condition for allowance. Thus, The Applicant respectfully requests early allowance of the instant application.

The Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-2135.

Respectfully submitted,

By /Brian A. Tollefson/
Brian A. Tollefson
Attorney for Applicant
Registration No. 46,338
ROTHWELL, FIGG, ERNST & MANBECK
1425 K. Street, Suite 800
Washington, D.C. 20005
Telephone: (202) 783-6040

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